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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,788	03/26/2004	Diane M. Ruezinsky	MONS:060US	9881

46795 7590 09/23/2005

FULBRIGHT & JAWORSKI, LLP  
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AUSTIN, TX 78745

EXAMINER

WORLEY, CATHY KINGDON

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/810,788

Applicant(s)

RUEZINSKY, DIANE M.

Examiner

Cathy K. Worley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-13 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10 and 12-13, drawn to a promoter comprising a polynucleotide sequence selected from a specified list, a construct comprising said promoter, a transgenic dicotyledenous plant transformed with said construct, a seed of said transgenic plant, meal from said transgenic plant, and a method of making meal and oil from said plant, classified in class 800, subclass 287, for example.
- II. Claim 11, drawn to oil from a transgenic plant comprising a construct comprising a promoter of a specified sequence, classified in class 554, subclass 8, for example.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are patentably distinct. The nucleic acids and transgenic plants of group I can be used for materially different purposes, such as for the production of a recombinant protein useful in the pharmaceutical or diagnostic industries. The oil of group II can be made by an alternative means, such as chemical synthesis, for example.

Searching for the promoter, construct, plant, meal, and method of group I will require a sequence search and a key word search for the gene from which the

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promoter was derived. Searching for the oil of group II will require a search in a different body of art which encompasses oil products and fatty acids. Because these searches are not coextensive, it would constitute an undue burden to examine both inventions.

This application contains claims directed to multiple polynucleotide molecules. Each of these are patentably distinct from each other because the polynucleotides are each unique molecules with different chemical and structural features. Applicants are reminded that unique nucleotide sequences are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq.

If group I is elected, then Applicant is required to select one nucleotide sequence from the following: SEQ ID NOs: 1-4. Claims that do not read on the elected sequence will be considered withdrawn. Applicant is advised that a reply to this requirement must include an identification of the sequence that is selected. An election that does not identify the sequence selected will be considered nonresponsive. This requirement is not to be construed as an election of species

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since each nucleotide sequence is not a member of a single genus of invention but constitutes independent and patentably distinct inventions.

A telephone call was made to Robert Hanson on Sept. 16, 2005 to request an oral election to the above restriction requirement, but did not result in an election being made because he would prefer to receive the restriction requirement in writing.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

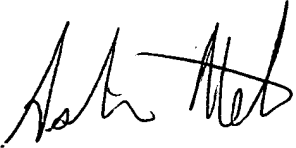
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cathy K. Worley whose telephone number is (571) 272-8784. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (571) 272-0745. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CKW  
Sept. 16, 2005



ASHWIN D. MENTA, PH.D.  
PRIMARY EXAMINER